

REMARKS

Applicant thanks Examiner Natalie Pass for the courtesies extended to Applicant's representative, Dinh Nguyen, during the personal interview on April 15, 2008.

During the interview, Applicant's representative explained Applicant's invention, and the deficiencies of the prior art with respect to the claimed limitations. Thus, Applicant's representative argued against the rejections made in the Office Action dated November 2, 2007 by discussing all of the prior art of record with respect to all of the pending claims. Amendments to the claims were proposed. Other issues were discussed which are all reiterated herein.

Claims 1-11 and 20-52 are pending. Claims 1, 11, 30 and 50-52 have been amended. More particularly, the limitation "wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal" has been added to these claims. Support for this amendment can be found throughout the present disclosure, for example, on page 8, lines 3-8 of the specification. Thus, no new matter has been added by way of this Amendment and entry of the Amendment is respectfully requested.

The Office Action rejects claims 50-52 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner alleges that the recitations of “comparing the customer data with the plan requirements data from the stored insurance product” and “proposal in the computer that is different from the stored insurance products” are new matter. Applicant respectfully traverses this rejection.

Applicant submits that these limitations were added in connection with the Examiner’s concerns during the personal interview on May 1, 2007, and that these limitations are fully supported in the original disclosure. First, the limitation “comparing the customer data with the plan requirements data from the stored insurance product” is fully supported in the specification at the bottom of page 12, as pointed out on page 15 in the Amendment filed on May 17, 2007. Page 12 of the disclosure states:

“The system can be built to recommend a health plan based on the requirements entered by the user. This function would allow the user to select a particular type of plan based on software requirements. The top portion of the HTML page would contain the user requirements. The bottom portion of the HTML page would contain the plans and these get evaluated based on the requirements entered by the user in the top page. The plan with the best match based on the user requirements would “bubble” to the top of the grid (emphasis added).”

Since user requirements are entered into the system, the customer data with

the plan requirements are stored along with the insurance products. When they are evaluated and the plan with the best match are found, the customer data was therefore compared with the plan requirements from the stored insurance product in order to obtain the best match.

It is noted that on page 22 of the Office Action, the Examiner states that at the bottom of page 12, the specification discloses comparison between the user requirements and the health plans. It appears that the Examiner is arguing that the “plan requirements” recited in the claims is not the same as the “user requirements” recited in the passage on page 12. Applicant respectfully submits that the Examiner is totally ignoring the entire passage and the specification as a whole. Since the health plans are compared to the user requirements, as admitted by the Examiner on page 22 of the Office Action, and the best matched plan is determined, then health plan requirements are obviously compared with the customer requirements. If not, how could a new customized proposal be determined, generated and offered to the customer?

Secondly, the limitation “proposal in the computer that is different from the stored insurance products” is fully supported in the original claims and specification. See claim 1 for example where it is recited that the customized proposal is generated by using at least a portion of the customer data. Further, on lines 5-7 of page 14 of the specification, the step of creating a new proposal is described. The

specifics of creating a new proposal is also described in the passage cited above and throughout the specification. During the interview of May 17, 2007, Examiner Pass and Primary Examiner Gilligan indicated that they were confused by the claim limitations as to what was created. Applicant's representative argued that the cited prior art does not disclose the generating of a customized proposal. As a result, this language was proposed to be added in the claims in order to clearly differentiate the claimed invention from the cited prior art.

Additionally, during the personal interview conducted on April 15, 2008, a review of the specification was made with respect to these two claim limitations. While Examiner Pass did not explicitly agree to withdraw this rejection, upon reviewing the paragraph bridging pages 7 and 8 of the specification (i.e., line 30 of page 7 to line 2 of page 8), the Examiner indicated that these two claim limitations appear to be clearly supported, based on this passage of the disclosure.

Thus, upon reconsideration, the Examiner should withdraw this rejection.

On page 4, the Office Action rejects claims 1 and 50-52 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner states that these claims recite "presenting a description of insurance plan options available to the customer" and also recite "the description of

insurance plan options including an indication that a particular insurance plan has been determined to not be currently available to the customer." The Examiner alleges that it is unclear how within a description of the insurance plan options available to the customer, there can be included an indication that a plan has been determined to be not available (emphasis added by the Examiner). Applicant respectfully traverses this rejection.

Applicant submits that the Examiner appears to be confused with the phrase "not currently available" to the customer for a plan that is compared to the customized plan that is ultimately offered and therefore available now to the customer. The claims are clear that a plan that may be offered but was not offered to the customer because it was not customized, meant that if a plan was not offered to a customer, it was therefore not available to the customer. However, if it is offered to the customer, then it is now available to the customer.

During the personal interview, Applicant's representative reiterated the above arguments to the Examiner. The Examiner understood these arguments. Accordingly, this rejection should be withdrawn.

On page 5, the Office Action rejects claims 1-11, 20-27, 30-47 and 50-52 under 35 U.S.C. § 103(a) as being obvious over Lockwood (U.S. Patent No. 4,567,359) in view of Warady (U.S. Patent No. 6,067,522) for substantially the same

reasons given in the prior Office Action. Somewhat similarly, the Office Action also rejects claims 28-29 and 48-49 under 35 U.S.C. § 103(a) as being obvious over Lockwood and Warady and further in view of Gamble et al. (U.S. Patent No. 6,163,770). The Examiner added further comments in response to Applicant's arguments in the Amendment, as indicated below. Applicant respectfully traverses this rejection.

The Examiner maintains her rationale for making the rejections but states on page 25 of the Office Action:

"As regards Applicant's arguments at page 21, lines 1-6 of the 17 May 2007 response that 'Warady's method does not disclose a determining step, a presenting step and a generating a customized proposal [step] based on the status of a particular plan that is not currently available to a customer and Warady does not disclose generating a customized proposal in response to unavailability of an existing plan,' Examiner notes that these are not claimed limitations (emphasis added by the Examiner)."

Applicant submits that the result of the claimed limitation is clear and thus the arguments above are in line with the claim limitations. From the Examiner's arguments as discussed above, it appears that the Examiner is reading certain limitations and certain passages in the disclosure out of context. Additionally, Applicant respectfully submits that the amendments discussed above, which have been incorporated in all of the independent claims, make it clear such that one cannot interpret the claims in the manner that was suggested.

In an effort to expedite prosecution of the instant application, Applicant has

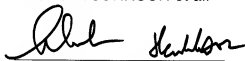
added the limitation "wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal" in the independent claims. Applicant respectfully submit that the cited prior art does not teach, suggest or mention anything relating to this feature.

Therefore, this rejection should be withdrawn.

In the event that the Examiner does not find the above amendments persuasive in overcoming the rejection, Applicant respectfully requests that the Examiner provides language that she considers acceptable.

In view of the above remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance of the claims are earnestly solicited. Should the Examiner believe anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,
Jerome D. JOHNSON et al.

A handwritten signature in black ink, appearing to read 'Abraham Herskovitz', is written over a horizontal line.

Abraham Herskovitz
Registration No. 45,294

Dinh X. Nguyen
Reg. No. 54,923

HERSHKOVITZ & ASSOCIATES, LLC
2845 DUKE STREET
ALEXANDRIA, VA 22314

703-370-4800 (telephone)
703-370-4809 (facsimile)

patent@hershkovitz.net